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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,917	02/14/2002	Thomas Thoroe Scherb	P21821	6255

7055 7590 05/15/2002

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EXAMINER

HASTINGS, KAREN M

ART UNIT	PAPER NUMBER
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1731

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DATE MAILED: 05/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

73917

Applicant(s)

Scherb et al

Examiner

HASTINGS

Group Art Unit

1731

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -1- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/14/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-11 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☒ received in Application No. (Series Code/Serial Number) 09/471,369
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-5, drawn to shoe pressing unit with nip length less than 60 mm, classified in Class 162, subclass 358.3.

II. Claims 6-8, drawn to web pressing process for at most 3 milliseconds, classified in Class 162, subclass 205.

III. Claims 9-11, drawn to web pressing process for at least 3.5 milliseconds, classified in Class 162, subclass 205.

The inventions are distinct, each from the other because of the following reasons:

Inventions II(with III) and I, respectively, are related as process and apparatus for its practice. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be practiced by a materially different apparatus, or (2) that the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In the instant case the process as claimed can be practiced by another and materially different apparatus such as one with a soft rubber belt which extends the press nip; the method claims do not require a shoe press unit for example only; furthermore, the apparatus as claimed can be used to practice another and materially different process such as one wherein the time of pressing is different than that claimed in the method

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claims since the time of pressing depends on the speed the machine is operated at which is not an apparatus limitation.

Furthermore, each of the process inventions II and III is drawn to an independent and distinct inventions since each recites limitations that are mutually exclusive; that is, for instance, in method independent claim 6, the time duration for pressing is at most 3 milliseconds whereas in independent claim 9, the time duration must be at least 3.5 milliseconds or more. Thus each of these claims (and in other aspects not explicitly detailed here, the parameters chosen are examples only) define mutually exclusive inventions. Thus even though inventions II and III may be classified in the same subclass, each set of claims requires a separate search to look for diametrically opposed limitations since these limitations are mutually exclusive. Furthermore, any text searching would require a different search for each invention and would be an additional burden on the search and analysis burden for these inventions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Groups I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hastings whose telephone number is (703) 308-0470. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5 P.M.

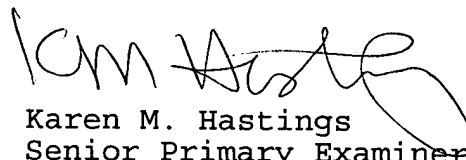
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steven Griffin, can be reached on (703) 308-1164. The fax phone number for this Group is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.


Karen M. Hastings
Senior Primary Examiner
Art Unit 1731

KMH/cdc
May 13, 2002

5/2002